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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,347	09/30/1999	KIKUO NAITO	35.C13894	5241
5514	7590	04/20/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			KIM, CHONG R	
		ART UNIT	PAPER NUMBER	
		2623	14	
DATE MAILED: 04/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/409,347	NAITO ET AL.
Examiner	Art Unit	
Charles Kim	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 February 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15,27,41,65 and 66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15,27,41,65 and 66 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 September 1999 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Response to Amendment and Arguments

1. Applicant's amendment filed on February 5, 2004 has been entered and made of record.
2. In view of applicant's amendment, the 112 second paragraph rejections have been withdrawn.
3. Applicant's arguments with respect to claims 1, 4-5, 10, 13-15, 27, 41, 67 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claim 15 is objected to because of typographical errors. It appears that the phrase "sure" in line 12 was meant to read "user". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 6, 8, 10-15, 27, 41, 65-66 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefik et al., U.S. Patent No. 6,233,684 ("Stefik").

Referring to claim 1, Stefik discloses an information processing apparatus comprising:

- a. discrimination means for discriminating a process (printing) in which an electronic watermark is to be applied to data that is to be registered (stored), from among a plurality of different processes (printing, viewing, playing, transmitting) that are executed for the data to be registered (col. 9, lines 3-11 and col. 12, line 10-col. 13, line 45)
- b. registration means for registering (storing) the data to be registered and management information (usage rights) based on the discrimination by the discrimination means so that the electronic watermark is applied to the data to be registered during the process (printing) discriminated by the discrimination means (col. 12, lines 1-36 and col. 13, lines 20-45).

Referring to claim 2, Stefik further discloses that the discrimination means discriminates between a process of registering the data (col. 12, lines 1-7 and col. 13, lines 26-28) and a process (printing) to be executed after registering the data (col. 13, lines 33-45).

Referring to claim 3, Stefik further discloses that the discrimination means discriminates among one of a process of registering the data (col. 12, lines 1-7 and col. 13, lines 26-28), a process of sending the registered data (col. 12, line 54-col. 13, line 2. Note that the registered data is sent to the "user" repository), and a process of printing the registered data (col. 13, lines 33-45).

Referring to claim 6, Stefik further discloses that the process of printing the registered data is for sending the data to a printer (col. 13, lines 33-45).

Referring to claim 8, Stefik further discloses that the printer deletes data received from the information processing apparatus when print of the data is completed (col. 16, lines 37-39). Note that the print spooler deletes the data after print has been completed).

Referring to claim 10, Stefik further discloses that the discrimination means further discriminates a method of applying an electronic watermark method among plurality of electronic watermarking methods (col. 11, lines 36-59).

Referring to claim 11, Stefik further discloses that the plurality of watermarking methods include at least a first method for employing an electronic watermark as visible information, and a second method for employing an electronic watermark as invisible information (col. 8, lines 51-59).

Referring to claim 12, Stefik further discloses that the plurality of electronic watermarking methods includes at least a third method for employing an electronic watermark as removable information, and a fourth method for employing an electronic watermark as unremovable information (col. 8, lines 55-56. Note that the visible watermark is removable and the invisible is unremovable).

Referring to claim 13, Stefik further discloses that the discrimination means further discriminates electronic watermark information to be applied to the data (col. 12, lines 8-51).

Referring to claim 14, Stefik further discloses a management means for managing the process (printing) determined by the discrimination means for each registered data (col. 16, lines 13-50).

Referring to claims 15, 27, 41, see the rejection of at least claim 1 above.

Referring to claim 65, Stefik discloses an information processing apparatus comprising:

a. decision means for deciding, based on an intended use of image data, a process (printing) during which an electronic watermark is to be applied to the image data from among a plurality of processes (printing, viewing, playing, transmitting) to be executed for the image data (col. 9, lines 3-11 and col. 12, line 10-col. 13, line 45)

b. registration means for registering (storing) the image data based on the decision by the decision means so that the electronic watermark is applied to the image in accordance with the decision by the decision means (col. 12, lines 1-36 and col. 13, lines 20-45).

Referring to claim 66, Stefik discloses an information processing system that executes a plurality of different processes for image data to be provided by a user, comprising:

a. decision means for deciding, based on an intended use of image data, a process (printing) during which an electronic watermark is to be applied to the image data from among a plurality of processes (printing, viewing, playing, transmitting) to be executed for the image data (col. 9, lines 3-11 and col. 12, line 10-col. 13, line 45)

b. registration means for registering (storing) the image data and management information (usage rights) based on the decision by the decision means so that the electronic watermark is applied to the image in accordance with the decision by the decision means (col. 12, lines 1-36 and col. 13, lines 20-45)

c. applying means for applying an electronic watermark to the image data based on the management information registered by the registration means (col. 12, lines 8-51 and col. 13, lines 20-44).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 (“Stefik”).

Referring to claim 9, Stefik does not explicitly disclose that during printing of the data by the printer, the printer does not halt printing of the data even upon receiving a halting instruction. However, Stefik discloses a printing process that protects the user in the situation where the printing may become inadvertently terminated before the digital work is completely printed (col. 13, lines 17-19). Therefore, it would have been obvious to continue the printing process even upon receiving a halt instruction. In the case where outputting the data requires a fee (Stefik, col. 13, line 13), one would be motivated to continue output even upon receiving a halt instruction, so that the user obtains the entire data that they paid for.

7. Claims 4, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Stefik et al., U.S. Patent No. 6,233,684 (“Stefik”) and Guedalia et al., U.S. Patent No. 6,148,333 (“Guedalia”).

Referring to claim 4, Stefik further discloses an outputting means for outputting (printing) the data (col. 15, lines 6-25), but does not explicitly disclose that the data is outputted

after the electronic watermark has been removed from the data. However, this feature was exceedingly well known in the art. For example, Guedalia explains that when a “premium user” requests an image from a server, the server processes the image so that an electronic watermark is not present in the image during output to the user (col. 13, line 57-col. 14, line 26). The Examiner notes that the combination of Stefik and Guedalia results in the “premium user” requesting an image from the server that already includes an electronic watermark (Stefik, col. 12, lines 8-51). Therefore, it would have been obvious to remove the watermark from the data before being output, in order to ensure that the premium user receives an image in which an electronic watermark is not present (Guedalia, col. 13, line 57-col. 14, line 26).

Stefik and Guedalia are combinable because they are both concerned with networks for controlling the distribution and use of rendered digital works through watermarking. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to output the data after the electronic watermark has been removed from the data. The suggestion/motivation for doing so would have been provide the premium user with an image that has not been deteriorated by a watermark. Therefore, it would have been obvious to combine Stefik with Guedalia to obtain the invention as specified in claim 4.

Referring to claim 5, see the rejection of at least claim 4 above. Stefik further discloses a display means for displaying data which the electronic watermark is applied to (col. 14, lines 40-51).

Referring to claim 7, see the rejection of at least claim 5 above.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ck
April 14, 2004


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